

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PHILIP L. NELSON

Appeal No. 96-3613
Application 08/335,496¹

ON BRIEF

Before COHEN, ABRAMS and CRAWFORD, Administrative Patent Judges.
COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 27 through 36. In the answer (page 2) dated May 30, 1996, the examiner indicates that claims 28 and 30 are now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the

¹ Application for patent filed November 7, 1994. According to appellant, this application is a continuation of Application 08/045,631 filed April 9, 1993, now U.S. Patent No. 5,373,991 issued December 20, 1994.

Appeal No. 96-3613
Application 08/335,496

limitations of the base claim and any intervening claims. Claims 8, 9, and 37 through 44, the only other claims remaining in the application, stand allowed. In light of the above, we have claims 27, 29, and 31 through 36 before us for review.

Appellant's disclosed invention pertains to a foam dispenser for dispensing a foaming liquid substance. An understanding of the invention can be derived from a reading of exemplary claim 27, a copy of which appears in the appendix to appellant's brief.

The following rejection is the sole rejection on appeal.

Claims 27, 29, and 31 through 36 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a specification which, as originally filed, does not support the claimed invention.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the answer filed May 30, 1996 (Paper No. 11), while the complete statement of appellant's argument can be found in the brief (Paper No. 10).

As to the rejection of claims 27, 29, and 31 through 36, appellant indicates (brief, page 7) that they stand or fall together. Thus, we select claim 27 for review and shall focus our attention exclusively thereon below; 37 CFR § 1.192(c)(7).

OPINION

In reaching our conclusion on the issue raised in this appeal, this panel of the board has carefully considered appellant's specification, drawing, and claims, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

We affirm the examiner's rejection of claim 27 under 35 U.S.C. § 112, first paragraph. It follows that claims 29 and 31 through 36 stand with claim 27.

The description requirement of 35 U.S.C. § 112, first paragraph, is separate and distinct from the enablement requirement. That one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is part of an appellant's invention. See In re Barker, 559 F.2d 588, 593, 194 USPQ 470, 474 (CCPA 1977). The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for

the claim language. Further, the content of the drawings may also be considered in determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

We are in accord with the examiner's stated position in the answer (Paper No. 11) to the effect that the subject matter of claim 27 lacks descriptive support in the original disclosure. It follows that claims 29 and 31 through 36 fall with claim 27.

A reading of appellant's originally filed specification, claims, and drawing readily reveals to us that this original disclosure simply does not convey that the present inventor had possession at that time of the now claimed undisclosed embodiment wherein the sealing surface protruding from the door is configured to seal with "the outer surface" of the dispensing passage, and the lock extending from the door is configured to engage "the inner surface" of the dispensing passage. As indicated above, the circumstance that one skilled in the art might realize from reading a disclosure that something is possible (an undisclosed variation) is not a sufficient indication to that person that the something is part of an

appellant's invention. We, of course, fully appreciate that, as a general proposition, a claim may be broader than the specific embodiment disclosed in a specification. However, an inventor is entitled to claims only as broad as a disclosure will allow. See In re Rasmussen, 650 F.2d 1212, 1214, 211 USPQ 323, 326 (CCPA 1981). In the present case, we, like the examiner, have determined that the claims on appeal are simply not descriptively supported by the underlying original disclosure.

The argument advanced by appellant in the brief (Paper No. 10) does not persuade us that the examiner erred in rejecting appellant's claims under 35 U.S.C. § 112, first paragraph.

In support of the view that the rejection is unsound, appellant argues (brief, pages 10 and 11) that an ordinarily skilled artisan would "realize" from a review of the original disclosure in this application that the disclosed sealing and locking relationships "could be" repositioned as a "variation" of the embodiment specifically disclosed. As is evident from our analysis, supra, this is not a convincing line of reasoning for overcoming the rejection before us based upon a lack of description (35 U.S.C. § 112, first paragraph).

We conclude by noting that appellant has indicated that as an "important feature" of the invention the door includes a

cylindrical projection (specification, page 9) and that the geometry of the foam dispensing passage and sealing cylindrical projection, inter alia, are such as to clear the dispensing passage and screen upon opening without any degradation in performance in producing foaming (specification, page 10). As discerned throughout the specification (pages 13 and 14, and page 16), the focus is upon sealing engagement of the projection with the "interior" surface of the dispensing passage, i.e., the cylindrical sealing exterior surface 60 seats against the cylindrical "interior" surface of the dispensing passage (specification, page 14). It appears to us that the undisclosed embodiment would require the lock to engage some structure (a pair of molded keepers, for example) on the inner (interior) surface of the dispensing passage downstream of the orifice and screen. In our opinion, the aforesaid structure (molded on the interior surface) which, of course, remains on the inner surface when the door is in opened position and the dispenser is in use, may reasonably be expected to effect some degree of degradation in performance in producing foaming, contrary to appellant's expressed expectation for the disclosed dispenser (specification, page 10). Thus, the undisclosed embodiment would not appear to us to have been contemplated by appellant within the framework of

Appeal No. 96-3613
Application 08/335,496

the original disclosure in this application. See Gentry Gallery, Inc. v. Berkline Corporation, 97-1076,-1194,-1182 (Fed. Cir. Jan. 27, 1998).

In summary, this panel of the board has affirmed the rejection of claims 27, 29, and 31 through 36 under 35 U.S.C. § 112, first paragraph.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	
NEAL E. ABRAMS)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
MURRIEL E. CRAWFORD)	
Administrative Patent Judge)	

Appeal No. 96-3613
Application 08/335,496

Joseph M. Rolnicki
Rogers, Howell & Haferkamp
7733 Forsyth Blvd., Ste. 1400
St. Louis, MO 63105